

REMARKS

Claims 26, 27, 32 and 33 are pending in this application; claims 28-31 have been cancelled. Reconsideration and allowance of this application is respectfully requested in light of the herein amendments and the submission of a co-filed RCE.

The Examiner continues to reject the claims as being anticipated by U.S. Patent No. 6,514,352 to Gotoh et al (“Gotoh”), and further in view of U.S. Patent No. 6,508,887 to Park et al (“Park”) and U.S. Patent No. 6,911,836 to Hada et al (“Hada”).

II. The 112 Rejections

Claims 26-27 and 32-33 stand rejected under 35 U.S.C 112, first paragraph. Claim 26 recites the limitation “residue remover is free of chelators”, and claim 32 recites a limitation “remover is free of chelating agents”. The Examiner asserts these limitations do not have support in the specification.

Support for these limitations is found in paragraph [0053] which states “But generally, chelators can be included in small amounts (e.g., between 0.01% and 0.1%), or alternatively the chelators could be deleted, especially if high purity (e.g., electronic quality, having very low metals content) ingredients were used to make the formulation.” (Emphasis added).

Under 112 para 2, the application ‘shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.’” Chiron Corp. v. Genentech, Inc., 363 F.3d 1247, 1253 (Fed. Cir. 2004) (quoting 35 U.S.C. § 112, ¶ 1).

In this case, the specification is crystal clear that the chelators in the “dilute aqueous cleaner and residue remover” could be deleted, such that the “cleaner and residue remover is free of chelators.” Accordingly, the Examiner’s § 112 ¶ 1 rejection was incorrectly applied. We are pleased to show the Examiner the support for such amendment.

II. The 103 Rejections

Claims 28-31 stand rejected under 35. U.S.C. 103(a) as being unpatentable over Gotoh (6,514,352) in view of Park (6,508,887) and Hada (5,911,836).

Claims 28-31 are canceled.

The Examiner has rejected claims 26-27 and 32-33 as being obvious over the Gotoh patent, in view of the Park patent and the Hada patent.

Claims 26-27 and 32-33, claim, *inter alia*, that the “cleaner and remover is free of chelating agents.” The Gotoh patent is to a method of cleaning using “a cleaning agent comprising an oxidizing agent, a chelating agent and a fluorine component....” col. 3, lines 5-7 (Emphasis added).

The chelating agent is an essential element of the formulations in the Gotoh patent and is included in every embodiment, example, and claim. The Gotoh patent expressly states “[t]he chelating agent used in the present invention includes....” and thereafter provides an extensive list of chelating agents to use in the formulation. col. 3, line 58 – col. 4, line 42. Further, the Gotoh patent states that “[i]f the chelating agent has a content of less than 0.01% by weight, the effect for preventing metal impurities from readhering is scarcely observed.” col. 4, lines 46-48. The Gotoh patent thereby teaches away from not using a chelating agent. Claims 32 and 33, however, expressly claim a method of using a composition free of chelators.

Obviousness under 35 U.S.C. 103 requires that every element is found in the cited references. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Gotoh does not disclose every element of claims 26, 27, 32 and 33 because Gotoh does not disclose a cleaning composition that is free of chelators. In fact, the Gotoh patent teaches away from such compositions.

Even if Park or Hada disclosed compositions that are free of chelators, it would be improper to combine the Gotoh patent – which teaches away from chelator-free cleaner and remover compositions – with references that teach such chelator-free compositions. The MPEP itself states: “[i]t is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).” MPEP 2145. There is no suggestion to combine, however, if a reference teaches away from its combination with another source. *Fine*, 837 F.2d at 1075, 5 USPQ2d at 1599. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result

sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). That is certainly the case here, a person of ordinary skill, upon reading the Gotoh patent and by his/her common sense, would be discouraged from using a chelator-free cleaner and remover. *See, KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. ___, 2007 WL 123787, at 12 (2007).

The Examiner argues that the Gotoh patent discloses "phosphonic acid derivatives" and somehow this overcomes the fact that the claims are to methods of using chelator-free cleaner and remover compositions. This term is not even in claims 32-33 and claims 26 and 27 are to specific inorganic acids, which are no where to be found in the Gotoh patent. The present invention simply used such acids as preferred acids. Claims 26-27 claim the use of the specific inorganic acids "sulfamic acid, phosphonic acid, or mixture thereof...." The Gotoh patent fails to disclose such inorganic acids and only identifies various organic acid chelating agents. One of skill in the art would NOT suddenly decide to this essential element of Gotoh was superfluous and then substitute an inorganic acid. Further, neither the Park patent, nor the Hada patent fill in the missing element. It is axiomatic that to render a claim obvious, all the claim limitations must be taught or suggested by the combined prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Because Gotoh, Park and Hada fail to disclose sulfamic acid or phosphonic acid, the combination cannot render claims 27 and 28 obvious. And because a chelating agent is an essential element of Gotoh, the combination of Gotoh, Park and Hada cannot render claims 32 and 33 obvious.

Where an independent claim is nonobvious, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, claim 29 is also nonobvious.

As previously argued, a further nonobviousness distinction is that, as conceded by the Examiner, the Gotoh patent fails to disclose 0.2 to 5% by weight of an alkanolamine in the cleaning solution and relied upon the Park and Hada references to argue it would be obvious "to incorporate the cited alkanolamine as disclosed by Park et al and Hada et al into the process of Gotoh et al...." However, again as conceded by the Examiner, one skilled in the art would consider the Seijo patent when considering the presently claimed invention and the Seijo patent teaches away from using an alkanolamine with an aqueous cleaner and remover because "the alkanolamine disassociates and creates an alkaline solution that accelerates the corrosion of

metals and dielectrics." Seijo, col. 2, 49-52. Therefore, one of skill in the art would NOT simply add alkanolamine into the cleaner disclosed by the Gotoh patent because one of skill in the art would believe it would disassociate and create an alkaline solution that accelerates the corrosion of metals and dielectrics, as disclosed in Seijo.

Accordingly, because the combination of Gotoh, Park and Hada fail to disclose elements of claims 26, 27, 32, and 33 and because it would not be obvious to simply add alkanolamine to Gotoh according to the teaching of the Seijo patent cited by the Examiner, claims 26-27 and 32-33 are not obvious and are believed to be in allowable form.

4. The Amendments

No new matter has been added by the amendments to the claims. Claim 26 has been amended to incorporate composition elements of claim 28 expressly.

III. Conclusion

No further fees are deemed necessary at this time; a Request for Continuing Examination (RCE) is filed herewith; no other fees are believed due in this matter. However, should any fees be deemed necessary please charge Morgan, Lewis & Bockius Deposit Account No. 50-0310.

Respectfully submitted,



October 31, 2007

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